

## REMARKS

Claims 1-46 are pending in the above application and have been rejected in the most recent Office Action. Applicants have added twenty-two (22) new claims 47-68 hereinabove, and a check in the amount of \$396.00 is included herewith for the same. Applicants respectfully traverse each ground of rejection and request reconsideration and further examination of the application. Applicants respond to each ground of rejection and objection as follows:

- A. Claims 1, 3, 6-12, 14-17, 19, 21-23, 25-38, and 41-46 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy (USPN 5,970,474), in view of Robertson (USPN 6,609,106).**

LeRoy discloses a system that allows users to use a product selection device to choose items in a retail store. The items are then communicated to a registry database on a host computer via a local area network (LAN). The registry database includes items that a user has selected using the product selection device. LeRoy also discloses a point of sale input device that identifies purchased items and updates the registry database to indicate which items have been purchased. LeRoy further discloses a system whereby registry databases at individual retail stores can be synchronized with a master registry database across a wide area network (WAN), such as the Internet.

Robertson discloses a system and method that allows users to create a gift registry including products from multiple on-line merchants. The selected items are then stored centrally in a database as elements of a wish list by sending information over the Internet to a centralized gift registry site. Robertson also discloses a system whereby individuals can make purchases for a registrant using the wish list. The wish list items can be searched and organized by price or category. Robertson also discloses that the purchase of all items in the wish list can be delayed

to a certain specified date corresponding to a future time or event. Additionally, registrants of the system can receive an automatic notification upon the arrival of the specified time or event.

The present invention claims a method and system “for shopping in a physical retailer and online.” (See Claim 1). Claim 1 requires a “handheld data entry unit including an internal memory” and a database that “stores item information corresponding to items scanned in the physical retailer in the internal memory of the data entry unit.” Claim 1 further requires “creating a wish list that includes the items; storing the wish list on the database” and “providing a web site that allows a user to generate one or more buy [or event] lists”. Each buy or event lists includes “one or more of the items from the wish list.” Applicants submit that the functionality of “[allowing] a user to generate one or more buy [or event] lists, each buy list including one or more items from the wish list” is non-obvious with respect to the prior art.

To establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all of the claim limitations. MPEP § 706.02(j). Specifically, the combination cited in the most recent Office Action does not teach “[allowing] a user to generate one or more buy [or event] lists, each buy list including one or more items from the wish list.” LeRoy discloses merely a system for creating a gift registry. LeRoy does not disclose a method or system for creating individual buy lists or event lists by selecting some subset of the items in the gift registry. Robertson merely discloses a system and method for creating a wish list. However, the Robertson wish list is not equivalent to the wish list of the present invention. In particular, Robertson does not disclose a method or system that would allow a user to create individual buy lists or event lists by selecting some subset of the items in the wish lists. Thus,

even if the two references are combined, they fail to show each of the required elements or limitations of Claim 1.

The difference between a wish list and a buy or event list, as well as the methods for generating each, is expressly articulated in each of the independent claims of the present application. Beginning with Claim 1, each independent claim contains specific claim limitations regarding the relevant differences between wish lists and buy or event lists. In Claim 1, the relevant portion of a method for shopping in a physical retailer and online includes:

- creating a wish list that includes the items;

- storing the wish list on the database;

- providing a website that allows a user to generate one or more buy lists, each buy list including one or more of the items from the wish list; and transmitting a message to a buyer in order to inform the buyer of the existence of one or more of the buy lists.

Likewise, each of the remaining independent claims contains similar language regarding wish lists and buy/event lists. In Claim 12, the relevant portion of a computer system for shopping in a physical retailer and online includes a processor programmed to perform several tasks, including:

- create a wish list that includes items corresponding to the item information downloaded to the database;

- provide a web site that is in communication with the database, the web site allowing a user to generate one or more event lists, each event list including one or more of the items from the wish list;

- allow the user to create an access mechanism that identifies a list of buyers that are allowed to access one or more of the event lists; and

- transmit a message to one of the listed buyers in order to inform the listed buyer of the existence of one or more of the event lists.

In Claim 21, the relevant portion of a computer server for hosting a system for shopping in a physical retailer and online includes a processor that, among other things, is programmed to:

- create a wish list from the data downloaded to the database, the wish list including the one or more items;

- provide a web site that is in communication with the database, the web site allowing a user to generate one or more buy lists, each buy list including one or more of the one or more items from the wish list; and

- transmit a message to a buyer in order to inform the buyer of the existence of one or more of the buy lists.

In Claim 28, the relevant steps of a method of receiving and communicating a list of one or more items over the Internet include:

- creating a wish list from the data downloaded to the database, the wish list including one or more of the items;

- providing a web site that is in communication with the database, the web site allowing a user to generate one or more event lists, each event list including one or more of the items from the wish list;

- allowing the user to create an access mechanism that identifies a list of users that are allowed to access one or more of the event lists; and

- transmitting a message to at least one of the listed users in order to inform the listed user of the existence of one or more of the event lists.

In Claim 30, the relevant steps of an Internet-based method of receiving and communicating a list of one or more items over the Internet include:

- providing a web site having a user interface including one or more user windows, the one or more windows providing an event list screen and a wish list screen;

- retrieving a list of one or more items;

arranging the one or more items into one or more wish lists on the wish list screen;

entering one or more events into an event list on the event list screen; assigning one or more of the items from the wish list to one or more of the event lists;

creating an access mechanism that identifies a list of buyers that are allowed to access one or more of the event lists; and

transmitting a message to at least one of the listed buyers in order to inform the listed buyer of the existence of one or more of the event lists.

In Claim 33, a computer system for shopping in a physical retailer and online is programmed to perform several tasks, which include:

create a wish list from the data downloaded to the database, the wish list including the one or more items;

provide a web site that is in communication with the database, the web site allowing a user to generate one or more event lists, each event list including one or more of the one or more items from the wish list; and

connect the user with an online retailer in order to add items to one or more of the event lists.

In Claim 38, a computer system for shopping in a physical retailer and online is programmed to perform several tasks, which include:

download data representing one or more items from a handheld data entry unit to a database;

create a wish list from the data downloaded to the database, the wish list including the one or more items;

provide a web site that is in communication with the database, the web site allowing a user to generate one or more buy lists, each buy list including one or more of the one or more items from the wish list; and

transmit a message to a concierge service to buy the items on one or more of the buy lists.

In Claim 43, the relevant portion of a computer system for shopping in a physical retailer and online, includes a processor, which, among other things, is programmed to:

allow a user to create a wish list including one or more items by shopping at one or more electronic retailers;

store the wish list on the database;

provide a web site that is in communication with the database, the web site allowing a user to generate one or more buy lists which include one or more of the items from the wish list; and

transmit a message to a buyer in order to inform the buyer of the existence of one or more of the buy lists.

Thus, a wish list is the set of all items that are selected by a user. Buy lists and event lists are subsets of wish lists. Wish lists and buy/event lists are functionally and structurally distinct.

Applicants submit that the independent claims of the present application establish that event/buy lists contain items individually selected from a wish list. Applicants further submit that this interpretation of the claim language is clearly consistent with and supported by the specification language of the application. The system and method claimed specifically allows users of the present invention to selectively choose which items from a wish list they wish to include in a buy list or event list. This functionality is established in the independent claims and disclosed in the specification.

LeRoy and Robertson each fail to disclose a method or system for allowing the creation of buy/event lists that are subsets of a wish list. Applicants submit that LeRoy and Robertson taken either individually or in combination, do not teach or suggest Applicants' claimed invention. The aforementioned first Office Action generally addresses wish lists and buy/event lists, but erroneously concludes that buy and event lists are *equivalent* to wish lists. The Office Action states, "[t]he mere act of exposing the wish list to others via the gift registry system

converts the wish list into a buy list from the perspective of others viewing the information who want to use the list to buy one or more items for the registrant” (3/1/2004 Office Action, page 3, paragraph 5). This interpretation fails to acknowledge the aspect of the present invention that “allows a user to generate one or more buy [or event] lists, each buy list including one or more items from the wish list.” Consequently, the Office Action fails to make out a *prima facie* case for obviousness. Therefore, Applicants’ independent claims 1, 12, 21, 28, 30, 33, 38 and 43 are not rendered obvious over LeRoy in view of Robertson.

Claims 3 and 6-11 depend from independent Claims 1; claims 14-17, 19 and 20 depend from claim 12; claims 22, 23 and 25-27 depend from claim 21; claim 29 depends from claim 28, claims 31 and 32 depend from claim 30; claims 34-37 depend from claim 33; claims 39-41 depend from claim 38; and claims 44-46 depend from claim 43, and therefore include all of the limitations of their respective base claims. It is, therefore, respectfully submitted that claims 3, 6-11, 14-17, 19, 20, 22, 23, 25-27, 29, 31, 32, 34-37, 39-41, and 44-46 are each allowable over the references of record for at least the same reasons as set forth above regarding their respective base claims.

**B. Claims 4-5, 18, and 24 were rejected under 35 USC § 103(a) as being unpatentable over LeRoy and Robertson, as applied to Claims 1, 3, 12, and 22, further in view of Official Notice (regarding access control lists).**

Claims 4-5 depend from Claim 1, either directly or indirectly, and are therefore allowable for the reasons stated above with respect to Claim 1. Claim 18 is dependent upon Claim 12, either directly or indirectly, and is therefore allowable for the reasons stated above with respect to Claim 12. Claim 24 is dependent upon Claim 21, either directly or indirectly, and is therefore allowable for the reasons stated above with respect to Claim 21. Additionally, the Official

Notice reference does not add any teaching to the LeRoy and Robertson combination that would contribute to an obviousness rejection of independent Claim 12.

**C. Claim 13 was rejected under 35 USC § 103(a) as being unpatentable over LeRoy and Robertson, as applied to Claim 12, further in view of Kraemer.**

Claim 13 is dependent upon Claim 12, either directly or indirectly, and is therefore allowable for the reasons stated above with respect to Claim 12. Additionally, the Kraemer reference does not add any teaching to the LeRoy and Robertson combination that would contribute to an obviousness rejection of independent Claim 12.

**D. Addition of new Claims 47-68.**

Dependent claims 47 through 68 have been added to set forth the handheld data entry unit of the corresponding independent claim being able to retrieve, display, and edit wish lists, buy lists and event lists. Additionally, the claims set forth the possibility of the handheld data entry unit being in wireless (radio frequency) communication with the database (or processor) of the corresponding independent claim. Applicants submit that the specification sufficiently supports the additional claims, and that these new claims add no new matter.

Finally, further submitted herewith are a Power of Attorney and Correspondence Address Indication Form and a Statement Under 37 CFR 3.73(b), each executed by an authorized officer of assignee Simon Property Group, LP ("Simon"). The undersigned would like to clarify the record to date that of the 12 original inventors identified in this application, 11 of those inventors have rightfully assigned their inventorship rights to Simon and that Simon contests any competing claims of ownership the 12<sup>th</sup> non-signing inventor may purport to have in the right,



title or interest to this patent application and the inventions claimed herein. Those inventors' assignments have been duly recorded as indicated in the enclosed Statement Under 37 CFR 3.73(b).

In the event Applicants have overlooked the need for an extension of time or payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 50-0410, BINGHAM McHALE LLP.

### CONCLUSION

Reconsideration of the present application in view of the foregoing arguments is respectfully requested. Applicants respectfully submit that the above represents a complete response to the Office Action of March 1, 2004, and that the application is in condition for allowance. Such action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel L. Boots", is written over a horizontal line.

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